

The opinion in support of the decision being entered today was not written for publication in a law journal and is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ITZHAK SHOHER
and
AHARON E. WHITEMAN

Appeal No. 1998-0239
Application No. 08/279,907

ON BRIEF

Before KIMLIN, PAK and DELMENDO, Administrative Patent Judges.
KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-12, all the claims in the present application. Claims 1 and 4 are illustrative:

1. A moldable dental composition comprising high-fusing temperature metal particles having a melting temperature above

Appeal No. 1998-0239
Application No. 08/279,907

the preselected temperature at which said dental composition is to be heat treated, with said particles having an irregular non-spherical geometry of which at least 50% have a cross-sectional average thickness of less than 1.5 microns, at least about 20% and up to 85% by volume of a volatile binder and carbonaceous particles in a concentration above at least 0.005 wt.% of the dental composition.

4. A moldable dental composition as defined in claim 3, wherein the determination of at least 50% of said particles having an average thickness of less than 1.5 microns is established by measuring the surface area of the largest two dimensional surface of each high fusing temperature metal particle, computing the total two dimensional surface area for all of the high fusing temperature metal particles in said composition and dividing the cumulative surface area of the high fusing temperature metal particles below 1.5 microns in average thickness by the total two dimensional surface area for all of the particles.

The examiner has not cited prior art in rejecting the appealed claims.

Appellants' claimed invention is directed to a moldable dental composition comprising high-fusing temperature metal particles having an irregular non-spherical geometry of which at least 50% have a cross-sectional average thickness of less than 1.5 microns.

Appealed claims 1-12 stand rejected under 35 U.S.C.
§ 112, second paragraph.¹

¹ The examiner's rejection under the judicially created doctrine of obviousness-type double patenting has been
(continued...)

Upon careful consideration of the opposing arguments presented on appeal, we will sustain only the examiner's rejection of claim 4 under § 112, second paragraph. Our reasoning follows.

Regarding the examiner's rejection of claims 1-3 and 5-12, it is the examiner's position that the following language of claim 1 is indefinite: "said particles having an irregular non-spherical geometry of which at least 50% have a cross-sectional average thickness of less than 1.5 microns." The examiner states the following at page 8 of the Answer:

The test which is described on pages 15-16 of the specification, and which is set forth in claim 4, is not a test to determine thickness, *per se*. Instead, the test is a test to determine what percentage of high fusing temperature metal particles have an average thickness of less than 1.5 microns. Specifically, in this case, the test is used to determine if at least 50% of the high fusing temperature metal particles have an average thickness of less than 1.5 microns.

Hence, it can be seen that the examiner acknowledges that appellants' specification discloses how to determine the number of high-fusing temperature metal particles that have a cross-sectional average thickness of less than 1.5 microns.

¹(...continued)
withdrawn (see Supplemental Examiner's Answer).

Since it is well settled that claim language is not to be read in a vacuum but in light of the specification as it would be interpreted by one of ordinary skill in the art,² the examiner has made the case why the rejection is not sustainable.

Although the examiner has set forth a scenario at pages 10-11 of the Answer how different calculations can result in different values, the examiner has not established that the criticized claim language would be indefinite to one of ordinary skill in the art when read in light of appellants' specification.

The examiner's § 112, second paragraph, rejection of claim 4 is based on the indefiniteness of "the particles" appearing in the last line, i.e., it is not clear whether "the particles" is referring to the high-fusing temperature metal particles, the low-fusing temperature metal particles, the carbonaceous particles, or the combination of all three particles. We find, however, no response by appellants to this rejection in their brief, and the examiner states at page 8 of the Answer that "[t]he examiner notes that no argument

² In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983); In re Moore, 439 F.2d 1232, 1235, 169 USPQ 236, 238 (CCPA 1971).

Appeal No. 1998-0239
Application No. 08/279,907

was presented regarding claim 4 and the question as to which particles are encompassed by 'the particles' as recited at the end of claim 4." Accordingly, since the examiner's rejection is reasonable on its face, and has not been rebutted by appellants, it will be sustained.

In conclusion, based on the foregoing, the examiner's rejection of claims 1-3 and 5-12 is reversed. The examiner's rejection of claim 4 is affirmed. The examiner's decision rejecting the appealed claims is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
)	
)	
)	
)	
CHUNG K. PAK)	BOARD OF PATENT
Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
)	
)	
ROMULO H. DELMENDO)	

Appeal No. 1998-0239
Application No. 08/279,907

Administrative Patent Judge)

ECK:clm

Appeal No. 1998-0239
Application No. 08/279,907

Eugene Lieberstein
2151 Long Ridge Road
Stamford, CT 06903